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MAILED

DEC 01 2010

OFFICE OF PETITIONS

In re Patent No. 5,967,784	:	
Issue Date: 10/19/1999	:	
Application Number: 09/114,697	:	ON PETITION
Filing Date: 01/13/1998	:	
Attorney Docket Number:	:	
1562-PAT	:	

This is a decision is in response to the petition under 37 CFR 1.378(b), filed on September 15, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

The patent issued on October 19, 1999. The first maintenance fee payment was timely made. The second maintenance fee could have been paid during the period from October 19, 2006, through April 19, 2007, or, with a surcharge, during the period from April 20 through October 19, 2007. Accordingly, this patent expired at midnight on October 19, 2007, for failure to timely remit the maintenance fee.

Petitioner, patentee Michael J. Powers, states, in pertinent part:

4. I was not aware that the patent had lapsed for failure to pay fees.
5. My patent attorney died before 2007. He was one of two or three members of a small local law firm, only one of whom remains in practice.
6. That firm has no records of having attempted to notify me about the fee deadline, but assured me it was their standard practice.
7. My orthodontic practice dissolved in about 2004 due to my disability, whereon I sold my practice to another practitioner and closed my office.
8. I have moved four times since then.
9. If the law firm did attempt to notify me about the coming fee deadline, that notice never reached me.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) the payment of the surcharge set forth in 37 CFR 1.20(i). This petition lacks item (1).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay"). Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.¹ In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person." Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995). This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133. In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

In view of In re Patent No. 4,409,763, this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

¹ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

² In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id.

At the outset, petitioner states that his previous patent attorney deceased "before 2007". Petitioner must provide the date that the attorney died or closed his practice in order to assist in the determination of whether the delay was unavoidable.

Additionally, as petitioner states that one of the attorneys who was a member of the law firm which petitioner's attorney was also a member is still in practice, it is unclear whether petitioner's counsel was associated with another attorney or law firm at the time of his death, whether that attorney had agreed to assume responsibility for matters concerning petitioner's attorney's clients in the event of the attorney's death or incapacitation, and whether the maintenance fees for the present patent were docketed in a reliable tracking system. Petitioner must also explain who, if anyone, took over the attorney's docketed caseload after his death, and what actions were taken to ensure that the attorney's cases were properly handled.

In this respect, petitioner should send a letter (accompanied by a copy of this decision) to the surviving partner(s) in the attorney's law practice, if any, or his legal representative, if no other attorney has acquired the law practice, by registered or certified mail, return receipt requested, indicating that the USPTO is requesting the assistance of the attorney's law firm and/or legal representative in determining the circumstances surrounding the expiration of this application, and is specifically requesting a statement as to who, if anyone, was responsible for docketing and payment of the maintenance fees for the present patent, and if the attorney's law firm or legal representative was responsible, why petitioner was not timely notified that the second maintenance fee was due. Such

statements should be accompanied by copies of any documents (e.g., correspondence between petitioner and counsel) relevant to the docketing of maintenance fees in this patent. In the event that the law firm or legal representative fails to provide a statement within a period (e.g., within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the attorney's law firm or legal representative with any renewed petition under 37 CFR 1.137(a).

Furthermore, as it is noted that it is petitioner who is ultimately responsible for the payment of maintenance fees, petitioner must explain what agreement existed between the patent attorney and petitioner regarding providing notice that the maintenance fees were due. Copies of any written agreements or other memoranda must be provided with any renewed petition.

The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions, or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative is a delay binding on petitioner. See Haines v. Quigg, *supra*; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). Furthermore, petitioner is reminded that the Patent and Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative. Ray v. Lehman, 55 F.3d 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). Petitioners were not forced, but rather made a conscious decision to obtain the services of the chosen representative in payment of the maintenance fees for this patent, and therefore must be held accountable for his actions, or lack thereof, before the Office.

Further, with regards to petitioner's assertion that his attorney's law firm failed to notify petitioner that the maintenance fee was due, in accordance with the law firm's standard practice, petitioner's reliance on his attorney to inform him as to when the maintenance fee is due merely shifts the focus of the inquiry from petitioner to whether the attorney or agent acted reasonably and prudently. Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). As such,

assuming that the agent had been so engaged, then it is incumbent upon petitioner to demonstrate, via a documented showing, that the attorney or agent had docketed this patent for the first maintenance fee payment in a reliable tracking system. Id. If petitioner cannot establish that agent had been so engaged, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee.

The above paragraph notwithstanding, petitioner is reminded that the failure of communication between an applicant and counsel is not unavoidable delay. In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b). See Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1878 (Fed. Cir. 1995). Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee. Id. Petitioners were not forced, but rather made a conscious decision to obtain the services of the chosen representative in payment of the maintenance fees for this patent, and therefore must be held accountable for his actions, or lack thereof, before the Office.

Lastly, with regard to petitioner's contention that he was unaware that the maintenance fee was due, a delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

In summary, while the circumstances surrounding the delay in payment of the second maintenance fee are unfortunate, the showing of record does not rise to the level of unavoidable delay. The petition will therefore be dismissed.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for expedited consideration is not refundable. The \$400.00 petition

fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

The address in the petition is different than the correspondence address. A copy of this decision will be mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. Petitioner should file a change of correspondence address if the correspondence address is to be updated.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
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 401 Dulany Street
 Alexandria, VA 22314

Patent No. 5,967,784
Application No. 09/114,697

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Telephone inquiries should be directed to the undersigned at 571-272-3231.



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Encl: Change of Correspondence Address-Patent

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